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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|----------------------------|------------------|
| 09/669,057 | 09/25/2000 | Bruce Brumberg | BRUM-101 | 2821 |
| 7590 Robert K Tendler 65 Atlantic Avenue Boston, MA 02110 | | | EXAMINER PATEL, JAGDISH | |
| | | | ART UNIT 3693 | PAPER NUMBER |
| SHORTENED STATUTORY PERIOD OF RESPONSE | | | MAIL DATE | |
| 3 MONTHS | | | 12/28/2006 | |
| | | | DELIVERY MODE PAPER | |

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/669,057

Applicant(s)

BRUMBERG, BRUCE

Examiner

JAGDISH PATEL

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3693

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is in response to amendment filed 9/25/2006

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/25/2006 has been entered.

Response to Amendment

3. Claim 1 has been amended. In response to the RULE 131 DECLARATION accompanied by and filed with the amendment dated 8/28/06 has been entered and accepted by the examiner. Accordingly rejection of claims over prior art references of "PaycheckCity.com Adds New Paycheck Calculators and Features to Successful Website," published May 2000, and the associated website page published June 9, 2000 have been withdrawn. However, prior art references predating the PayCheckCity.Com have been found and applied against the amended claims are found. (see analysis under prior art rejection).

Claim Rejections - 35 USC § 112

4. Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Independent claim 1 recites calculating “stock option exercise outcome..related to gain upon exercise of an option based on the proposed hypothetical inputs” without specifying any specific algorithm or procedure or other basis for calculating the “projected stock option exercise outcome”. Therefore, the claim is rendered indefinite because the outcome of the calculation cannot be definitive. Instead it will depend upon how the calculation is performed.

6. Claims 7 and 9 recite limitation “the model” which lacks antecedent basis in the amended claim 1.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-16 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In order to be patentable subject matter under 35 USC the claimed invention must produce “useful concrete and tangible result”. The claimed invention while producing useful and tangible result fails to produce “concrete” result. (see explanation under 35 USC 112 (second)). Usually, a claimed invention is not concrete when a result cannot be assured or is not reproducible. In other words, the process must have a result that can be substantially repeated.

Claim Rejections - 35 USC § 103

8. Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over article listed below and referenced as Prior.

Title: Wealth watch.

Authors: Prior, Chris

Source: Treasury & Risk Management; Aug99, Vol. 9 Issue 6, p64, 2p

Document Type: Article

Subject Terms: *STOCK options
*EMPLOYEE stock options
*MANAGEMENT
Software

Abstract: Discusses the use of stock options management software in managing employee stock option programs in the United States. Internet-based products that reduce a plan administrator's hand-holding role; Trading capabilities of Internet services; Drawbacks of Internet-based stock option programs.

The Prior reference teaches that the need already existed for providing access to stock options management software (as of Aug 1999), which enable individual employees to monitor the stock option plan and help them “gauge the value of their options and assist them in selling their shares and keeping their records straight”. Furthermore, Prior teaches existence of “a variety of Internet-based products” that facilitates administration of the employee stock option plans.

Prior also addresses various features concerning employee stock option plans such as tax and accounting implications.

Prior teaches a method of providing an individual who is an employee of a company with education and training about the individual's employee stock option plan for a specific stock to

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permit the individual to make intelligent choices in the management of the individual's stock option plan substantially as recited in the instant claims since it helps the individual employee to gauge the value of their options and "assist them in selling their shares and keeping their tax records straight". Prior teaches that such functionality is provided by "a variety of Internet-based products". Prior, inherently discloses the education and training process as recited in the claims inherently because (a) the stock options management software is Internet-based and tailored to the needs and stock options policies and procedure because each stock option plan is company specific (b) the stock options software allow the participant employee to learn or educate himself concerning his specific stock option accounts, (see "employees gauge the value of their options and assist them in selling their shares"). The process steps of storing information about the individual's stock option plan relative to a specific stock of the company, calculating at the central server a projected stock option exercise outcome based on the user-selected hypothetical inputs concerning the stock option plan, the calculating being related to gain upon exercise of an option based on the proposed set of hypothetical inputs; user-selected hypothetical inputs concerning the stock option plan, the calculating being related to gain upon exercise of an option based on the outcome for the specific company stock, and providing the stock option exercise outcome that is the result of the calculation done at the central server to the individual on a terminal connected to the Internet at the individual's site, such that information about the stock option plan is provided back to the individual over the Internet taking into account the individual's hypothetical inputs are inherently disclosed by the Prior reference.

Note that no patentable weight is accorded to the limitation "to permit the individual to make decisions which will result in the optimization of the value of the individual plan" since

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this limitation is only intended use of the "information about the stock option plan.

Alternatively, it is also asserted that this limitation is met by the cited prior art in view of the analysis provided.

Regarding claims 2-6, 8 and 10-16, it is asserted that various features claimed therein are essential to the management of the stock option plan and in general any investment strategy.

It would have been obvious to one of ordinary skill in the art at the time of the invention to further incorporate such features in the claimed process

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAGDISH PATEL whose telephone number is (571) 272-6748.

The examiner can normally be reached on 800AM-630PM Mon-Tue and Thu.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **KRAMER JAMES A** can be reached on **(571)272-6783**. The fax phone number for the organization where this application or proceeding is assigned is 517-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Jagdish N. Patel

(Primary Examiner, AU 3693)

12/18/06